

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 1/18/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CableTrim, Inc.

Serial No. 76522619

Mary J. Gaskin, Esq. for CableTrim, Inc.

Alec Powers, Trademark Examining Attorney, Law Office 101
(Ronald R. Sussman, Managing Attorney).

Before Quinn, Hohein and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by CableTrim, Inc. to
register the mark CABLETRIM for "wood moldings."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground
that applicant's mark, as applied to applicant's goods, is
merely descriptive thereof.

¹ Application Serial No. 76522619, filed June 13, 2003, based on
an allegation of a bona fide intention to use the mark in
commerce.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.² An oral hearing was not requested.

The examining attorney maintains that the mark merely describes decorative wood molding, also called "trim," that functions to hide cable wires running along interior walls. The examining attorney, relying on dictionary definitions, contends that each of the words "cable" and "trim" has descriptive significance relating to the nature of applicant's goods, and that the combination of the two words retains a merely descriptive character. The examining attorney also submitted excerpts from applicant's web site.

Applicant argues that its mark is suggestive, and that the examining attorney has not met his burden of proof in showing that the mark is merely descriptive. According to applicant, each of the two words comprising the mark has numerous meanings, and that the combined terms do not immediately identify a purpose or function of the goods. Applicant contends that the word "cable" is taken from the

² Throughout the examination of this application, including the final refusal, the basis of the refusal was mere descriptiveness. Applicant and the examining attorney clearly understood this, and the issue was argued in the respective briefs. Thus, we do not understand the paragraph in the examining attorney's brief (pp. 5-6) relating to genericness. We can only conclude that the examining attorney made a mistake.

electronics field, and that this word has never been associated with moldings or "trim" in the building trade. Thus, applicant argues, its mark is an incongruous juxtaposition of words, and customers must utilize thought or perception to determine what characteristic or feature the mark describes. In urging that the refusal to register be reversed, applicant submitted third-party registrations of TRIM-formative marks purportedly similar to applicant's mark; photographs of applicant's goods; promotional information about the goods set forth in a PowerPoint® presentation prepared by applicant; and promotional materials regarding two other wood molding products sold by third parties.

A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant

attribute, function or property of the goods or services.
See In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); and In re MBAssociates, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in different contexts is not controlling. In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, e.g., *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

In order to properly analyze the issue, it is imperative to understand the nature of applicant's goods. Applicant describes its goods as "decorative moldings that, after installation, form passageways for wiring and associated components." (Response, July 9, 2004, p. 3).

Applicant's PowerPoint® slides, created to promote the goods, reveal additional information about the goods. The goods were developed in response to "explosive growth in home automation, computer networking, security, audio/video and in home theater/entertainment systems" and the "expanding need for additional home low-voltage cabling and wiring i.e. phone, co-axial, twisted pair, speaker wiring, fiber optics, etc." Applicant describes its "solution" for "low voltage wiring concealment" as follows: "A complete, attractive system of removable wood moldings with hidden brackets to provide continuous routing channels for low-voltage wiring, connecting components and control systems throughout the home." This same information appears on applicant's web site.

The term "cable" is defined, in pertinent part, as "a strong, large-diameter, heavy steel or fiber rope; something that resembles such steel or fiber rope." The term "trim," as defined in the same dictionary, means, in relevant part, "exterior ornamentation, such as moldings or framework, on a building." The American Heritage Dictionary of the English Language (3d ed. 1992).³

³ The examining attorney, in his appeal brief, refers to an additional dictionary definition of the term "trim" showing it defined as "the lighter woodwork in the finish of a building especially around openings." Merriam-Webster Online Dictionary (www.merriam-webster.com). The examining attorney should have

The term "cable" is a commonly understood and recognized term, and, as shown by the evidence of record, applicant's goods function to conceal cable wires.

The dictionary definition shows that the term "trim" refers to moldings, and applicant concedes "the term 'trim' is infrequently used to describe interior moldings."

(Response, July 9, 2004, p. 3). We note that applicant itself, in its brief, uses the term "trim" to refer to its goods: "the product is not trim for a cable, but is trim designed to be installed on the interior surfaces of a room." (Brief, p. 6).

Based on the evidence of record, we find that the terms "cable" and "trim" are at least merely descriptive terms when applied to applicant's wood molding. The combined term CABLETRIM also is as merely descriptive as the individual terms. When the proposed mark is viewed in the context of applicant's goods, the term immediately informs prospective customers that applicant's goods comprise trim that is designed to conceal electronic cable.

The fact that applicant may be the first and only user of the merely descriptive term CABLETRIM does not justify

introduced this online dictionary definition earlier in the examination phase. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). Accordingly, the definition has not been considered. In any event, the definition is essentially cumulative of the other listings already of record.

registration inasmuch as the only significance conveyed by the term is merely descriptive. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

The five third-party registrations of TRIM-formative marks relied upon by applicant are not persuasive of a different result. While uniform treatment under the statute is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular matter sought to be registered is merely descriptive. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."]; and In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

We conclude that the proposed mark CABLETRIM is merely descriptive of wood molding or "trim" used to conceal cable wires running along interior walls and floors.

Decision: The refusal to register is affirmed.